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|----------------------------|---------------|----------------------|---------------------|------------------|
| APPLICATION NO.            | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/617,959                 | 07/11/2003    | Wealthy Desai        | 030160 (9400-33)    | 4469             |
| 396072                     | 7590          | 08/06/2009           | EXAMINER            |                  |
| AT&T Legal Department - MB |               |                      | LIU, CHIA-YI        |                  |
| Attn: Patent Docketing     |               |                      | ART UNIT            | PAPER NUMBER     |
| Room 2A-207                |               |                      |                     | 3696             |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                       |
|------------------------------|--------------------------------------|---------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/617,959 | <b>Applicant(s)</b><br>DESAI, WEALTHY |
|                              | <b>Examiner</b><br>CHIA-YI LIU       | <b>Art Unit</b><br>3696               |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 April 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-14, 31-33 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11-14, 31-33, and 49-52 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 11-14, 31-33, and 49-52 are presented for examination. Applicant filed a RCE on 4/9/2009 requesting for continued examination. Independent claims 11, 31 and 49 have been amended and Claim 15-16, 53-54 are canceled. After careful consideration of Applicant's arguments and amendments, new grounds of rejections have been established as set forth in detail below.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-14 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter. To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. (See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876))

Claims 31-33 and 49-52 are rejected under 35 U.S.C. 101 because they merely recite a computer program product for use with a computer. In order to be properly claimed, the computer program code must be embodied in a static medium and it must be computer- or machine-executable. It is not clear which computer or machine elements are being instructed by the recited "module/computer-readable program code". While a computer program product can be static media, there are possible interpretations for the claimed computer program product as being a more abstract and fleeting product, such as a carrier wave or signal. It is recommended that claims 31-33 and 49-52 be amended to explicitly limit the computer program product to static media

and it should be explicitly recited that the computer program instructs a processor to perform the recited functionality. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31-48 and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. System/apparatus claims are defined by their structure elements and any corresponding functionality. "Module" and "computer-readable program code" do not impart structure.

Regarding Claims 11, 31 and 49, the phrases "and/or" and "credit/debit" render the claim indefinite because it is not clear whether "and/or" means "and" or "or" and whether "credit/debit" means "credit or debit." Appropriate correction is required.

Regarding Claims 11, 31 and 49, the phrase "electronically accessing an electronically linked electronic image" renders the claim indefinite. The word "link" means "to join or connect." It is unclear what system/apparatus/machine does the "electronic linked image" link to. Appropriate correction or clarification is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 11-14, 31-33, and 49-52 are rejected under 35 U.S.C. 103(a) as being obvious over Weibel (US 7,099,837 B1) in view of Applicant's Background of Invention, further in view of Official Notice, further in view of Bricklin et al. (5,717,939), further in view of Thompson et al. (US 6,282,552 B1), further in view of Rabideau et al. (US 2002/0010664 A1) and further in view of Gropper (US 6,883,000 B1)

As per Claims 11, 31, 49

Weibel ('837) discloses

electronically linking the electronic image and the electronic invoice (the billing statement (=invoice, see column 3, line 5) and each associated advertisement copy may be electronically accessed through links to one another), see column 2, lines16-18

Weibel ('837) teaches electronically accessing an electronically linked electronic image of an advertisement and an electronic invoice, see Abstract of Weibel, lines11-13 (advertisement and page documents are associated with the billing statement and linked so that they may be access by the client) and column 2, lines16-21 (electronically accessed through links) but fails to explicitly disclose granting access to the electronically linked electronic image and electronic invoice by the business directory publisher. Applicant admitted in the Background of invention that a CMR sells business directory advertisement to customers for the business directory publisher are well known to those having skill in the art and that the business directory publisher generate tear page (advertisement image) and send to the CMR along with an invoice, see Applicant's Background of Invention, lines 17-26. Since the CMR are granted access to the image and invoice by the business directory publisher in the traditional paper method, Official Notice [now admitted prior art] is taken it was old and well-known to grant access to information electronically. (It would have been obvious to grant the same person access to the same information electronically) Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include granting access to the electronically linked electronic image and electronic invoice by the business directory publisher. One would be motivated to do so for the benefit of allowing the business directory publish to know how much was billed to his/her customer and for what advertisement.

Weibel ('837) teaches generating electronic invoice for an advertisement (creating digital document representing an invoice for printed advertisement), see column 6, lines 11-12, but fails to explicitly disclose generating a customer

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electronic invoice for the advertisement from the CMR electronic invoice.

Applicant admitted in the Background of invention that CMRs are well known to those having skill in the art and that a customer invoice is generated from the CMR invoice (The publisher sends the tear page to the CMR along with an invoice. The CMR may add a commission and generate its own invoice which is sent to the CMR's customer) Since the customer invoice can be generated from the CMR invoice in the traditional paper method, Official Notice [now admitted prior art] is taken that it is old and well-known in to generate invoice electronically. (It would have been obvious to generate the same customer invoice from the CMR invoice electronically.) Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include generating a customer electronic invoice for the advertisement from the CMR electronic invoice. One would be motivated to do so for the benefit of generating a new invoice by transferring data from an associated invoice and simply adding additional data related to the new invoice that's not in the old one, thereby speeding up the invoice creation process.

Weibel ('837) teaches granting electronic access to an advertising customer to the electronic image and customer electronic invoice that are electronically linked, see column 6, lines 7-18, but fails to explicitly disclose the advertising customer is a CMR customer. Applicant admitted in the Background of invention that CMRs are well known to those having skill in the art and that CMRs sell advertisements and send invoice to CMRs customers, see Applicant's Background of Invention, lines 17-26. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include the advertising customer is a CMR customer. One would be motivated to do so for the benefit of allowing CMR customer to view the invoice and advertisement that are electronically linked so he/she could know how much to pay to CMR for the service.

Weibel ('837) teaches electronic invoice (digital document representing an invoice), see Claim 1 (e) of Weibel, but fails to explicitly disclose the CMR electronic invoice comprising an electronic spreadsheet having data fields therein. Bricklin ('939) teaches an electronic invoice comprising an electronic spreadsheet having data fields therein, see Fig 3 of Bricklin. Official Notice is taken that the type of electronic invoice does not affect the manipulative steps of the invention. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include the CMR electronic invoice comprising an electronic spreadsheet having data fields therein. One would be motivated to do so for the benefit of calculating and editing invoice data more easily.

Weibel ('837) does not specifically disclose the advertisement is a business directory advertisement that was sold by a third party Customer Marketing Representative for a business directory publisher to a CMR customer and the type of invoice is a CMR electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer. Official Notice [now admitted prior art] is taken that the type of advertisement and invoice do not affect the manipulative steps of the invention. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include the advertisement is a business directory advertisement that was sold by a third party Customer Marketing Representative for a business directory publisher to a CMR customer and the type of invoice is a CMR electronic invoice for the business directory advertisement that was sold by the CMR to the CMR customer. One would be motivated to do so for the benefit of creating billing statement for publishing business automatically and digitally to make for easier storage, retrieval and delivery.

Weibel ('837) fails to explicitly disclose the customer electronic invoice is generated by adding an additional data field to the data fields in the electronic spreadsheet and/or by altering a data field in the electronic spreadsheet. Bricklin ('939) teaches an electronic invoice comprising an electronic spreadsheet having modifiable data fields therein, see Fig 3 of Bricklin. Thompson ('552) teaches generating invoice (see figure 2 (210)) and changing electronic invoice by modifying/altering fields, see at least Abstract of Thompson. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include the customer electronic invoice is generated by adding an additional data field to the data fields in the electronic spreadsheet and/or by altering a data field in the electronic spreadsheet. One would be motivated to do so for the benefit of modifying invoice data more easily.

Weibel ('837) teaches generating an electronic invoice for the advertisement (creating digital document representing an invoice for printed advertisement), see column 6, lines 11-12, but fails to explicitly disclose sending an electronic CMR credit/debit form to the business directory publisher that indicates that an error was made in the CMR electronic invoice for the advertisement in response to detecting the error. Rabideau ('664) teaches a debit form that indicates that an error was made in the invoice (error notification is often called an invoice or debit memo), see paragraph 0005, lines 9-12. It is obvious to send error message in response to detecting the error. Both Weibel

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and Rabideau are directed toward invoice transaction system. Official Notice [now admitted prior art] is taken that it is old and well known to send out forms electronically. Furthermore, applicant admitted in the Background of Invention that it is well known in the art that Business directory publisher sends invoice to the CMR, see Background of Invention, lines 16-26 and Applicant admits in the Specification page 11-12 that "CMR credit/debit memo and electronic CMR adjustment form are commonly used in conventional business directory advertising. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include sending an electronic CMR credit/debit form to the business directory publisher that indicates that an error was made in the CMR electronic invoice for the advertisement in response to detecting the error. One would be motivated to do so for the benefit of allowing the business directory publisher to know that an error has been made in the invoice so he/she can calculate the value of the loss and request payment.

Weibel ('837) teaches generating an electronic image of an advertisement (creating digital document representing printed advertisement image), see column 6, lines 7-8, but fails to explicitly disclose sending an electronic CMR adjustment form to the business directory publisher that indicates that an error was made in the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher in response to detecting error. Applicant admitted in the Background of invention that a CMR sells advertisement to customers for the business directory publisher are well known to those having skill in the art, see Applicant's Background of Invention, lines 17-26. Gropper ('000) teaches ads in digital form, see column 36, lines 32-33 and displaying a message indicating errors (Z errors) and provide the user opportunity to resolve errors, correct incomplete data transmissions, see column 32, lines 40-44. Furthermore, applicant admits in the Specification page 11-12 that "CMR credit/debit memo and electronic CMR adjustment form are commonly used in conventional business directory advertising. (Examiner notes that the type of advertisement does not affect the inventive steps of this invention, therefore is not given patentable weight) Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include sending an electronic CMR adjustment form to the business directory publisher that indicates that an error was made in the business directory advertisement that was sold by the CMR to the CMR customer for the business directory publisher. One would be motivated to do so for the benefit of allowing the business directory publisher to make corrections and fix the errors in the advertisements.

As per Claims 12, 32, 50

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Weibel ('837) teaches granting electronic access to an advertising customer to the electronic image and customer electronic invoice that are electronically linked, see column 6, lines 7-18, and accessing digital documents through hypertext links, see column 2, lines 4-6, but fails to explicitly disclose sending an email to the CMR customer including a hyperlink to the electronic image and electronic invoice that are electronically linked. Applicant admitted in the Background of invention that CMRs are well known to those having skill in the art and that CMRs sell advertisements and send invoice to CMRs customers, see Applicant's Background of Invention, lines 17-26. Official Notice [now admitted prior art] is taken that it is old and well known in the art to send hyperlink through email. (For example, Yahoo Mail allows user to insert hyperlinks when composing an email.) Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include sending an email to the CMR customer including a hyperlink to the electronic image and electronic invoice that are electronically linked. One would be motivated to do so for the benefit of allowing the customer to access the electronic invoice image to pay for the bill.

As per Claims 13, 33, 51

Weibel ('837) teaches granting electronic access to an advertising customer to the electronic image and customer electronic invoice that are electronically linked, see column 6, lines 7-18, but fails to explicitly disclose grant electronic access by sending an email to the CMR/MR including a userid and/or password that may be used to electronically access the electronic image and electronic invoice that are electronically linked. Applicant admitted in the Background of invention that CMRs are well known to those having skill in the art and that CMRs sell advertisements and send invoice to CMRs customers, see Applicant's Background of Invention, lines 17-26. Since the advertisement image and invoice are sent to the CMR customer in the traditional paper method, it would have been obvious to grant access to the same information to the CMR customer electronically. Official Notice [now admitted prior art] is taken that it is old and well known to send userID and password to someone to allow the person to gain access to restricted information and it is also old and well known to send electronic text over computer network through an email. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include grant electronic access by sending an email to the CMR customer including a userid and/or password that may be used to electronically access the electronic image and customer electronic invoice that are electronically linked. One would be

motivated to do so for the benefit of allowing the CMR/MR to access the electronic invoice image to pay for the bill.

As per Claims 14, 52

Weibel ('837) teaches generating a Portable Document Format (PDF) file that contains the image of the advertisement (provides a digital representation of pages or ad images in PDF format), see column 5, lines 6-8, but fails to explicitly disclose the PDF is read only. Official Notice [now admitted prior art] is taken that it is old and well known to generate read-only PDF file. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Weibel's invention to include generating a read-only Portable Document Format (PDF) file that contains the image of the advertisement. One would be motivated to do so for the benefit of preventing the customer from accidentally click on the image and change the advertisement information.

Also, Examiner notes that, as per MPEP § 2144.03(C), the statements of Official Notice made in the art rejection that have not been traversed have been established as admitted prior.

#### ***Response to Arguments***

Applicant argues that incorporation of a spreadsheet would the intended operability of Weibel. The Examiner disagrees. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Therefore, Applicant's argument is not persuasive.

Applicant argues that it would not be predictable to add Rabideau's auditing process for the airline industry into a business directory advertisement. The Examiner disagrees. Rabideau teaches "an error notification called an invoice/debit memo," see paragraph 0005. It would be obvious that the error notification can be used in Weibel to notify error in the invoice. It would have been obvious to one of ordinary skill in the art at the time of the invention to include an error notification debit memo as taught by Rabideau in the system of Weibel, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, Applicant admits in the Specification page 11-12 that "CMR credit/debit memo (1080 form) are

commonly used in conventional business directory advertising." Therefore, Applicant's argument is not persuasive.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TOM DIXON can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHIA-YI LIU/  
Examiner  
Art Unit 3696

/Frantzy Poinvil/

Primary Examiner, Art Unit 3696

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